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Office Action Summary	Application No. 09/577,798	Applicant(s) MERRIMAN ET AL.	
	Examiner Jennifer I. Harle	Art Unit 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-57 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>See O.A.</u> | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Claims 1-57 are pending. Claims 1-57 are rejected and this action is made **FINAL**. This action incorporates the arguments set forth in the Request for Reconsideration filed April 24, 2002 and the amended claims set forth in the Supplemental Amendment filed September 20, 2002.

Amendment Filed September 30, 2002

Applicant filed amended claims on September 30, 2002 and a Notice of Non-Compliant Amendment (37 C.F.R. 1.121) was mailed. The Notice of Non-Compliant Amendment (37 C.F.R. 1.121) is vacated because clean sets of amended claims are not required for reissue applications.

Information Disclosure Statement

Applicant indicated that they have not received the following IDS pages/documents:

- Documents listed in Notification Regarding Litigation filed August 25, 2000
 - These documents were duplicated in the IDS filed July 24, 2001, paper number 12 and enclosed. These documents have been reviewed and the examiner has also provided an initialed copy of Notice, paper number 4.
- Three page PTO-1449 filed April 4, 2001
 - The examiner did not have a Three page IDS filed that date. The examiner had three separate IDS filed July 24, 2001, one of which was in the file directly behind the cover sheet for the April 4 IDS and was considered paper number 10, a copy of which was forwarded. As the

references are not part of the file, only the US patents for this IDS have been reviewed.

- Pretrial motions and orders listed on pages 2-3 of IDS filed July 24, 2001.
 - This IDS was designated paper number 12. These documents have been reviewed and an initialed copy has been forwarded with this action.
- Six page PTO-1449 filed July 24, 2001.
 - This IDS was designated paper number 11. These documents were reviewed September 24, 2001 and forwarded with the previous office action. An additional copy is being sent for Applicant's file.
- Two page Supplemental Information Disclosure Statement
 - This IDS was designated paper number 15, which was misnumbered paper number 16. These documents were reviewed September 24, 2001 and forwarded with the previous office action, paper 16. An additional copy is being sent for Applicant's file.
- Two page PTO-1449 filed September 7, 2001
 - This IDS should have been part of paper number 15, which was misnumbered paper 16. The documents initialed have been reviewed.
- Three page PTO 1449 filed September 7, 2001
 - This IDS should have been part of paper number 15, which was misnumbered paper 16. The documents initialed have been reviewed.
- One page PTO 1449 filed May 7, 2002
 - This corresponds to paper number 22 and is enclosed.

- Three page PTO 1449 filed September 30, 2002
 - This corresponds to paper number 25 and is enclosed.

The examiner believes that all documents now submitted have been reviewed and a copy of the IDS setting forth the documents, initialed and signed, forwarded to Applicant. If there are any discrepancies, Applicant is invited to contact the examiner to clarify the missing IDSs.

Response to Arguments

Requirement for Information Under 37 C.F.R. § 105 Satisfied

Applicant's response to the outstanding 37 C.F.R. §105 has been received. A new §105 requirement has been set forth to further clarify the outstanding issues.

Rejection Based on Defective Oath/Declaration Overcome

The new reissue declaration has been received to cure the original defective oath/declaration. The rejection of claims 1-57 is withdrawn based upon the new reissue declaration.

Double-Patent Rejection Over Co-pending Patent Applications Deferred

The double patenting rejection is maintained and made final. Applicant may file a terminal disclaimer when claims are in condition for allowance.

New Declaration Under 37 C.F.R. § 1.131 Submitted

Applicant's new 37 C.F.R. § 1.131 Declaration, filed April 24, 2002, has been received. The examiner acknowledges that it meets the requirements to establish that the invention was completed by an actual reduction to practice prior to May 1996.

Kohda, Wexler, Angeles Are Removed as Prior Art

The rejections under 102(a), 102(e) and 103(a) as they pertain to Kohda, Wexler and Angeles are withdrawn in light of Applicant's new 37 C.F.R. § 1.131 Declaration, filed April 24, 2002.

Claims Are Not Anticipated By Reilly

Applicant argues that Reilly does not teach or suggest a user node requesting advertising content from an advertisement server node by means of a link message provided to the user node from a content provider affiliate node. However, Reilly would inherently have the link message set forth as the user node in Reilly would access the content provider affiliate node, i.e. the news story items, and the would have a link message to the advertisements, i.e. a means/redirect to go from the news story items to the advertisements, within the Information database. Without a link message, the method would not be possible because connecting information with the database requires linking of the different segments. Additionally, the independent claims do not require that the link message function as set forth in the arguments. The link messages as claimed could function in other ways, such as the content provider affiliate sends a link message to the user node for tracking purposes, as does the advertiser node's link message. As applicant has not set forth the reasoning behind why Reilly does not have this element but merely sets forth the claim language, the rejection of claims 1-57 is maintained and **made final**.

The Claimed Invention Was Not On Sale More Than One Year Prior to the Filing

Date of the '061 Patent (On-Sale Bar Rejection Under 102(b))

Applicant argues that the rejection of claims 1-57 under 35 USC 102(b) based upon an alleged sale of the claimed invention is improper because:

- The Examiner did not present any argument or evidence that the claimed invention was ready for patenting at the time of the alleged offer for sale or any time prior to the critical date
- The events that took place prior to the critical date do not constitute a commercial offer for sale because the telephone conversation does not rise to the level of a commercial offer for sale as it was not one by which the other party could make a binding contract by simple acceptance because it lacks specific terms and thus did not trigger the on-sale bar.

Applicant's argument that the examiner failed to provide any argument or evidence that the claimed invention was ready for patenting at the time of the alleged offer for sale is not persuasive. Applicant filed the patent application less than one week after the "alleged" sale occurred. The examiner contends that the filing of the application within such a close proximity to the sale constitutes ready for patenting. Applicant has not submitted any evidence to show that any activity of any nature related to patentability occurred within this window. Additionally, the deposition testimony, sworn to under oath by Christopher Buckingham states that Kevin O'Connor told him that they could target ads based on demographics and the ability to interpret

the TCP/IP addresses and utilization of AdJump. Moreover, letter sent by Kevin O'Connor talks about the targeting of advertisements in the present tense and deployment of enhancements, i.e. IAF within 2-3 weeks. This evidence demonstrates that the invention was ready for patenting at the time of the sale. As Applicant has not provided any evidence to the contrary, Applicant's argument is not persuasive.

Applicant argues that the telephone conversation does not rise to the level of a sale and states that the letter is dispositive on this issue. However, the sworn deposition testimony specifically states that Christopher Buckingham was expecting to be invoiced based upon the telephone call. Buckingham Deposition pg. 48. Additionally, the Buckingham Deposition specifically states that the terms under "I suggest" in the letter are merely recitations of what was previously agreed to between the parties. Buckingham Deposition, pg. 42. Moreover, the letter states in the past tense "I enjoyed our discussion last week and am pleased that you will be one of our initial advertising sponsors" and "we are excited about working with you" and talks about the system in the present tense. October 30, 1995 letter from Kevin O'Connor to Chris Buckingham. Thus, the telephone conversation did not lack the specifics necessary for Christopher Buckingham to make a decision about buying targeted advertising. Finally, Applicant has not provided any evidence, including a more detailed contract than the letter or any sworn statements refuting the sworn deposition testimony of Christopher Buckingham. The evidence clearly demonstrates a meeting of the minds, one by which the other party could make into a binding contract by simple acceptance. Christopher Buckingham believed he had accepted the sale on the date of

the telephone conversation and nothing in the record disputes this sworn statement, which is supported and reinforced by language of the letter memorializing the conversation. Applicant's arguments that no sale occurred because it was just a proposal until the letter is not deemed persuasive nor are the arguments that there were not enough concrete terms to allow the parties to form a contract. Applicant's argument that Kevin O'Connor's Declaration that Mr. Buckingham requested a written proposal is not borne out by the Deposition testimony quoted in the Declaration. The series of questions taken together from the Deposition on pages 71-73 demonstrate that Mr. Buckingham has no recollection of asking for a proposal and distinctly remembers saying in the phone conversation "I can throw \$20,000 into this" because he was under budget for marketing and when the letter was sent Mr. Buckingham clearly believes this to memorialize the conversation. Thus, as there is a discrepancy, no further discussions and/or writings after the letter have been provided,¹ and Mr. Buckingham remembers agreeing to the sale during the phone conversation, this argument is not deemed persuasive.

The rejection of claims 1-57 is maintained and **made final**.

The Claims Are Not Anticipated by FocaLink

Applicant's argue that in order for a claim to be anticipated under 35 USC 102, a single prior art reference must disclose, either expressly or inherently, each and every element of the claims as set forth in MPEP 2131. However, the MPEP clearly states that in some circumstances, it is permissible to use multiple references in a 35 USC 102

¹ The offer was accepted on the phone as set forth in the deposition transcript. This has not been

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rejection. MPEP 2131. These reasons include use to show that a characteristic not disclosed in the reference is inherent. MPEP 2131.01. Thus, the primary reference LinkMarket Business Plan (DX89). The inherent features are supported by additional documents as set forth in the rejection.

Applicant further argues that none of the cited references disclose a system or method for electing an advertiser node or advertising banner based upon information stored about the user node at the advertisement server node and that the advertisement server node selects the advertisement/banner based on a number of times a content has been previously displayed. However, this is not the case. SmartBanner technology, i.e. the advertisement server node, stores information about the user node based upon the domain name of the user and targets from there. DX93 specifically states that the post-buy information can be used to target ads, including changing the graphics. This specific information includes information about the user node, i.e. demographics of those who view or click on an advertisement and the number of people per day who view/click on an advertisement. In order to target based on these features, this information would have to be stored and then used in selecting the advertisement/banner. Additionally, the LinkMarket Business Plan specifically states that the post-buy information is stored at the advertisement server node. Moreover, the user node can be broad enough to encompass the domain name, as a node is merely a junction of some type or a location on a tree that can have links to one or more nodes below it, and thus, the SmartBanner targeting clearly encompasses the present

disputed/rebutted and hence the offer and acceptance of the sale occurred during the phone

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invention as user's are targeted based on domain names and rotations apply to the domain names as well. Applicant has not set forth how the LinkMarket/FocaLink product differs in its operation from the claims and/or why it does not operate in the same fashion but merely reiterates the claim language. See also the discussion of SmartBanner technology. Thus, applicant's arguments are deemed not persuasive and the rejection of claims 1-57 is maintained and **made final**.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer I. Harle whose telephone number is 703.306.2906. The examiner can normally be reached on Monday through Thursday, 6:00 a.m. to 5:00 p.m..

conversation.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P. Olszewski can be reached on 703.305.9643. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Jennifer Ione Harle
December 12, 2008